

REMARKS

The Final Office Action withdrew the Section 101 rejection but maintained its rejection of claims 1-3, 5, 8, 17, 18-22, 26, 33, 45, 48, 50, 56-58 and 61-64 under Section 102(e) as anticipated by Frey (6,369,908). Claims 4, 6, 7, 10-16, 23, 25, 32, 46, 47, 49 and 51-55 were rejected under Section 103(a) as unpatentable over Frey and Official Notice. Further, claims 9, 24, 34, 35 and 37-43 were rejected under Section 103(a) as unpatentable over Frey in view of PR News article.

As discussed below, Applicants traverse the rejections and respectfully submit that all claims are in condition for allowance.

The Section 102 Rejection

Claims 1-3, 5, 8, 17, 18-22, 26, 33, 45, 48, 50, 56-58 and 61-64 were rejected under Section 102(e) as anticipated by Frey (6,369,908).

Frey cannot anticipate each of the independent claims since Frey does not collect images from a plurality of customers into a kiosk, and transferring images from the kiosk to an image-processing provider. The present invention provides apparatus and methods for accepting and storing image data from each one of a plurality of customers, for example at a kiosk, then transferring and again storing the digital image data to a central processing facility for processing and distribution per instructions from the customer. As defined on page 13 of the specification, the image processing provider can be an online photofinisher. Such centralization is convenient and advantageous in economy of scale when performing photofinishing.

In contrast, Frey's interactive photo kiosk is for creating, storing and distributing electronic images, audio messages, and text messages electronically. FIG. 2 of Frey contains a flowchart describing the basic process and the operation of the photo kiosk used for the electronic creation, storage and distribution of images, audio, and text messages. Frey is completely silent on the specifics of "in response to receipt of a first poll request at the kiosk and if the data structure is available, sending data structure address information corresponding to the available data structure from the kiosk to the image-processing provider via the communications medium; in response to receipt of the sent data structure address information at the image-processing provider, sending a data-

structure-fetch request across the communications medium from the image-processing provider to the kiosk."

At best, Frey shows capturing a picture, sound clip and text of one user and emailing the captured data to an email address. Frey cannot send images from a plurality of customers and transfer these images to one image processing provider, for example an on-line photofinisher. If Frey were to send all images to one email address, this would violate the user's privacy. Hence, the Office Action is incorrect in asserting that Frey shows the transferring of images from the users to the image-processing provider.

Since Frey lacks at least two elements of the claimed invention, it cannot anticipate the independent claims and those dependent therefrom. Withdrawal of the Section 102 rejection is respectfully requested.

The Section 103 Rejection

Claims 4, 6, 7, 10-16, 23, 25, 32, 46, 47, 49 and 51-55 were rejected under Section 103(a) as unpatentable over Frey and Official Notice. Claims 9, 24, 34, 35 and 37-43 were also rejected under Section 103(a) as unpatentable over Frey in view of PR News article.

First, these claims overcome the Section 103 rejection because they depend from allowable independent claims. Further, Applicants note that the MPEP Section 2143.01 - Suggestion or Motivation To Modify the References - has pronounced that a statement that modifications of the prior art to meet the claimed invention would have been " 'well within the ordinary skill of the art at the time the claimed invention was made' " because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references.

Applicants note that no motivation or suggestion, either in the cited art reference or in the knowledge generally available to one of ordinary skill in the art, has been cited by the Examiner to modify the Frey reference so as to produce the claimed invention. As noted above, the Frey reference fails to teach or suggest collecting images from a plurality of customers into a kiosk, and transferring images from the kiosk to an image-processing provider. The PR reference news article used to reject claims 9, 24, 34, 35

and 37-43 also fails to teach or suggest collecting images from a plurality of customers into a kiosk, and transferring images from the kiosk to an image-processing provider.

Further, Applicants fail to identify any motivation to modify the reference teaching so as provide transferring images from the kiosk to an image-processing provider as presently claimed. In fact, the Frey reference teaches away from Applicant's invention as one skilled in the art would have been generally discouraged from transferring images from the kiosk to an image-processing provider since Frey expressly teaches sending data one at a time to an email address.

Applicants point out that the Examiner bears the initial burden of factually establishing and supporting any *prima facie* conclusion of obviousness. *In re Rinehart*, 189 U.S.P.Q. 143 (CCPA 1976); M.P.E.P. § 2142. If the Examiner does not produce a *prima facie* case, the Applicant is under no obligation to submit evidence of nonobviousness. *Id.* In the instant case, the Examiner has not pointed to any evidence in Frey, or how knowledge of those skilled in the art, provide a suggestion or motivation to modify the reference teaching so as to produce the claimed invention. See *In re Zurko*, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001) ([I]n a determination of patentability the Board cannot simply reach conclusions based on its understanding or experience - or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings).

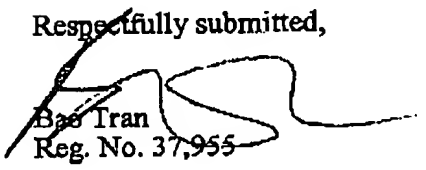
Under *Vaeck*, absent any evidence of a cited suggestion or reasonable motivation in the Andreiko et al. reference, or knowledge of those skilled in the art, for interpolating positional differences to produce successive digital data sets of tooth arrangements, *prima facie* obviousness of the claims has not been established. As such, it is respectfully requested that the § 103(a) rejection of claims, 6, 7, 10-16, 23, 25, 32, 46, 47, 49 and 51-55 be withdrawn and the claims be allowed. Similarly, the § 103(a) rejection of claims claims 9, 24, 34, 35 and 37-43 should be withdrawn.

CONCLUSION

Applicants believe that the above discussion is fully responsive to all grounds of rejection set for the in the Office Action dated April 15, 2003.

If for any reasons the Examiner believes a telephone conference would in any way expedite resolution of the issues raised in this appeal, the Examiner is invited to telephone the undersigned at 408-528-7490.

Respectfully submitted,


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